

REMARKS

Claims 1-8, 12-77 are pending in the present application, and new claims 78-83 have been added by the present amendment. Claims 1, 13-14, 17, 21-22, 25, 30-37, 41, 46-47, 49-50, 54-55, 61, 66-67, 70 and 74-75 have been amended hereby. It is respectfully submitted that no new matter has been presented and no new issues have been raised by the present response.

The undersigned would like to thank the Examiner for his time and assistance during the telephone conference of April 6, 2006.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 17 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. New claims 78-80 have been added positively claiming the tip affixed to the nozzle portion, as required by the Office Action. Claim 17 has been amended to depend from new claim 78. Similarly, claims 41, 47, and 49 have been amended to depend from new claim 79, claims 61 and 67 have been amended to depend from new claim 80, and claim 70 has been amended to depend from new claim 78.

Regarding claim 22, and other claims directed to such, the Office Action states that "... it is unclear how the pressure one exerts on the device cannot exceed 14 psi. (atmospheric pressure)" (see Office Action, p. 4, lns. 10-14). Claim 22 recites: "a handheld pipette as claimed in claim 21 wherein portions of said pipette which come in contact with the operator's hand are ergonomically designed so that contact pressure at no point on said pipette exceeds 14 psi." It is respectfully submitted that neither claim 22, nor other claims directed to such, recite an application of atmospheric pressure, as stated in the Office Action.

Withdrawal of the rejections under 35 U.S.C. § 112, second paragraph is respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1-2, 4-5, 12-13, 15-24, 30-31, 36, 38-41, 45-52, 54-58, 60-61, 65-66, 68-72 and 74-77 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,246,559 to Clifford (hereinafter "Clifford"). It is respectfully submitted, however, that Clifford does not teach or suggest every element recited in independent claims, including:

- "a piston member operable for preventing the liquid from entering into the nozzle portion," as recited in independent claims 1, 30-31, and 36.

As understood by Applicants, Clifford relates to a fluid sample analyzing apparatus. The apparatus includes a cuvette assembly, whereby fluid is introduced into the cuvette for optical analysis (see Clifford, col. 1, lns. 8-11; col. 4, lns. 31-66). The liquids are "force fed" into the cuvette and sucked therefrom along a common channel (see id., lns. 35-40).

In contrast, in the present application, the piston member prevents the liquid from entering into the nozzle portion. Accordingly, only air moves within the nozzle portion of the pipette of the present application. It is respectfully submitted that there is no teaching or even suggestion in Clifford of aspirating and dispensing liquid without the liquid entering the nozzle.

Accordingly, it is respectfully submitted that claims 1, 30-31, and 36 are patentable over Clifford. Furthermore, claims 2, 4-5, 12-13, 15-24, 69-70 depend from claim 1, claims 38-41, 45-52, 54-57 depend from claim 30, and claims 58, 60-61, 65-66, 68, 71-72, and 74-77 depend from claim 31, and are therefore believed to be patentable over Clifford at least by virtue of their dependence from patentable independent claims.

Rejections under 35 U.S.C. § 103(a)

Claims 3, 6-8, 25-29, 32-35, 42-44, and 62-64 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Clifford in view of U.S. Patent No. 2,796,204 to Math (hereinafter "Math").

Applicants respectfully traverse these rejections, and submit that neither Clifford nor Math, alone or in combination, disclose or suggest each of the elements of the rejected claims, including:

- "at least one button located on the top of the body portion and operable by a thumb of the operator to effect aspiration and dispensing of liquid, the at least one button being aligned with or substantially aligned with the vertical central axis of the body portion; a piston member operable for preventing the liquid from entering into the nozzle portion," as recited in independent claims 1, 25, and 32-35.

Math relates to a dispenser cap for dispensing liquids from bottles or containers and which may be attached to a bottle neck or other container opening; like in Clifford, the liquid enters the spout of Math (see Math, col. 1, lns. 27-40). In contrast, independent claims 1, 25, and 32-35 recite "a piston member operable for preventing the liquid from entering into the nozzle portion."

Claims Including a "hook"

Further, Applicants respectfully submit that Math does not teach a "hook" that is (1) "adjustable", as recited in claims 7, 26, 27, 34, 43, 63 and new claim 83, and (2) "removably mounted to said body portion, said hook being replaceable with a hook of different size/shape to accommodate at least one of user preference and different hand sizes", as recited in claims 8, 28, 35, 44 and 64.

The Office Action relies on elements 42 and 37 of Math as teaching a "hook" that is "adjustable" and "removably mounted ...", as recited in the above-enumerated claims. However, element 37 is a spring, not a "hook", as the term "hook" is used in the claims of the present application. Indeed, element 37 in Math is not suggested as being used as anything other than a spring. Moreover, assuming *arguendo*, that element 42 is a "hook", Math teaches that element 42 is stationary and not replaceable --Math does not suggest that element 37 is "adjustable" or "removably mounted ...".

Accordingly, Applicants respectfully request that the rejections of claims 7, 26, 27, 34, 43, 63 and new claim 83, and claims 8, 28, 35, 44 and 64, be withdrawn.

Claims 14, 47, and 67 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Clifford in view of U.S. Patent No. 6,737,023 to Kelly et al. (hereinafter "Kelly et al.>"). It is respectfully submitted that claim 14 depends from independent claim 1, claim 47 depends from independent claim 30, and claim 67 depends from independent claim 31, and are therefore believed to be patentable over the cited references at least by virtue of their dependence from patentable independent claims.

Claims 20, 37, 53, and 73 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Clifford in view of U.S. Patent No. 5,983,733 to Strandberg et al. (hereinafter "Strandberg et al.>").

It is respectfully submitted that claim 20 depends from independent claim 1, claim 53 depends from independent claim 30, and claim 73 depends from independent claim 31, and are therefore believed to be patentable over the cited references at least by virtue of their dependence from patentable independent claims. Regarding independent claim 37, it is respectfully submitted that there is no identification in the Office Action of any motivation or suggestion in the cited references to combine the teachings of the references in the manner indicated by the Office Action, nor of any reasonable expectation of success of such a combination.

Other Rejections and Objections

Regarding the remarks contained in the section of the Office Action entitled "Claim Interpretations," specifically, regarding the reference to "ergonomically shaped", Applicants have amended the respective claims by either deleting the term "ergonomically" or changing the term "ergonomically designed" to --shaped--. Applicants submit, however, that although these claims have been amended the scope of the claims still include a button with an ergonomic shape. Regarding the other objections, Applicants respectfully disagree that the enumerated claim recitations do not structurally limit the device (see Office Action, p. 2, ln. 5 to p. 3, ln. 11). These claim limitations provide structural limitations on the pipette as claimed.

Further, the Office Action indicates that "... as to claims 25 and 32-37, the preamble should be amended to recite operable for aspirating and dispensing fluid through a nozzle" (see Office Action, p. 3, lns. 3-5). It is respectfully submitted that Ho et al. is not a "pipette," as recited in the claims, and that the container of Ho et al. does not aspirate and dispense liquid without the liquid entering the nozzle.

Claim Elements Not Addressed In Office Action

It is respectfully submitted that the Office Action has not addressed several elements recited in the pending claims of the present application, including at least:

- "a nozzle portion extending from a point on said body portion and at a downward angle θ of approximately 60° to 80° to the vertical central axis of said body portion," as recited in claims 1 and 32-37;
- "said nozzle angle θ is adjustable," as recited in claims 3, 39, and 59;
- "said button is operated in a direction at a selected angle to said nozzle," as recited in claims 12, 45, and 65;
- "said body has a stable base permitting said pipette to stand upright on a surface," as recited in claims 16, 49, and 69;
- "pipette parameters, including at least the angle θ of said nozzle to an axis of said body portion and length of said tip affixed to said nozzle, are selected such that said tip does not touch said surface," as recited in claims 17, 50, and 70;

- "said body portion has a bottom which is removable at least in part to provide access to the pipette," as recited in claims 18, 51, and 71;
- "an adapter selectively mountable to said body portion, said adapter adjusting the size of said body portion to better fit operator hand size," as recited in claims 19, 36, 52, and 72;
- "an adapter attachable to said hook to accommodate at least one of user preferences and different hand sizes," as recited in claim 29; and
- "a button on said body which controls ejection of a tip from said nozzle, said button being ergonomically shaped to minimize contact pressure on the operator's hand when the button is operated", as recited in claims 14, 47 and 67.

Accordingly, Applicants respectfully request that each of these elements be addressed either by being rejected over one or more prior art references or by allowing the associated claims.

Conclusion

This communication is believed to be fully responsive to the Office Action and every effort has been made to place the application in condition for allowance. The claims are

believed to be patentable over the cited references, and a favorable Office Action is hereby earnestly solicited.


If an additional telephone interview would be of assistance in advancing prosecution of the present application, the Examiner is respectfully invited to telephone the undersigned at the number provided below.

If any fee is due in connection with the present response, the Commissioner for Patents is hereby authorized to charge the requisite fee to our deposit account number 02-0393.

Respectfully submitted,

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By:


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